

REMARKS

Claims 1, 28, 29, 44, and 61 have been amended to further clarify the invention. The last 2 claims (previously incorrectly numbered 73 and 75) have been renumbered as claims 75 and 76. With these amendments, claims 1-17, 19-33, and 35-76 are pending.

Applicants acknowledge and thank the Office for the allowance of claims 69-75, and for the Office's indication that claims 3, 9, 14-16, 27, 31, 40, and 67-68 would be allowable if rewritten in independent form to include all the limitations of the claims from which they depend.

Claims 1-2, 4, 6-8, 10, 12-13, 17, 19-24, 28-30, 32-33, 35-39, and 41-66 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,938,617 ("Vo-Dinh") in view of U.S. Patent 5,978,095 ("Tanaami"); claim 5 stands rejected under § 103(a) as being unpatentable over Vo-Dinh in view of Tanaami, further in view of U.S. Patent 5,973,842 ("Spangenberg"); claims 11 and 25 stand rejected under § 103(a) as being unpatentable over Vo-Dinh in view of Tanaami, and further in view of U.S. Patent 5,477,332 ("Stone"); Claim 26 stands rejected under § 103(a) as being unpatentable over Vo-Dinh in view of Tanaami, and further in view of U.S. Pre-Grant Publication 2002/0176801 ("Giebeler").

The Office contends that Vo-Dinh discloses the claimed invention, except for the optical pattern generator configured

to convert the light of the second wavelength into light having a pre-selected intensity pattern and the optical relay structure configured to project the light having the preselected pattern onto the examination area, where the projected pattern conforms to the arrangement of sample sites. Office Action, page 3.

Tanaami is cited by the Office as allegedly disclosing a pinhole array that converts incident light into a pattern, and a lens configured to project light having a preselected pattern onto the examination area. Office Action, page 3. The Office further points to Tanaami as disclosing that the projected pattern substantially conforms to the arrangement of sample sites. *Id.* From this, the Office concludes that it would have been obvious "to have used the system for directing light as disclosed by Tanaami with the invention as disclosed by Vo-Dinh in order to increase the accuracy of the detection area or to precisely pinpoint the sample area." *Id.* Applicants respectfully disagree with the Office's position.

As noted by the Office, Vo-Dinh does not disclose an optical pattern generator for converting light into light having a preselected intensity pattern, or a system wherein the light having the preselected intensity pattern is projected onto the examination area, and where the projected pattern substantially conforms to the arrangement of sample sites.

Tanaami describes confocal microscopic equipment which includes a beam splitter, a pinhole array, an objective lens, and a detector. Tanaami, col. 2, lines 46-57.

Applicants respectfully submit that the Office has not properly shown the requisite suggestion in the prior art that would lead a skilled person to make the claimed invention. According to the Office, a person of ordinary skill in the art would combine Vo-Dinh and Tanaami in order to increase the accuracy of Vo-Dinh's detection area and to precisely pinpoint the sample area. However, there is no suggestion in the references indicating a need to increase the accuracy of the detection area in Vo-Dinh or to precisely pinpoint Vo-Dinh's sample area.

Further, even if a need to increase the accuracy of Vo-Dinh's detection area or to precisely pinpoint the sample area were identified, the Office has not shown that this need would be satisfied by combining Tanaami's pinhole array with Vo-Dinh's instrument. Indeed, it is not clear from the Office Action how the need would be satisfied by adding a pinhole array to Vo-Dinh's instrument.

Even if one were motivated to combine Vo-Dinh and Tanaami, the combination does not include all the elements of the claimed invention. Vo-Dinh is acknowledged to not disclose a system that projects light having a preselected pattern onto the examination area, where the projected pattern substantially

conforms to the arrangement of sample sites. Tanaami is alleged to disclose this element. However Tanaami only discloses a pinhole array that is configured to project a pattern of light (spots) onto the sample. This pattern of light does not substantially conform to the sample sites. First, because Tanaami only discloses one sample site not a multiplicity of sites. Second, the spots in Tanaami do not substantially illuminate even the single sample. They are spaced away from each other at the sample.

Regarding the Spangenberg and Stone references, it is respectfully submitted that neither of these references cures the deficiencies in Vo Dinh and Tanaami discussed above. Consequently, the references do not support the rejection.

Claim 26 stands rejected under § 103(a) as being unpatentable over Vo-Dinh in view of Tanaami, and further in view of U.S Pre-Grant Publication 2002/0176801 ("Giebeler").

While Applicants do not agree with the Office's conclusion that claim 26 is obvious over Vo-Dinh in view of Tanaami, and further in view of Giebeler, the rejection is irrelevant because, under 35 U.S.C. § 103(c), Giebeler is not prior art to the instant application.

The Manual of Patent Examining Procedure discusses rejections under 35 U.S.C. § 103(c) and points out that:

[e]ffective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter

and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

Manual of Patent Examining Procedure, Eighth Edition, Section 706.02(1)(1).

The subject application was filed October 29, 2001, and has an earliest priority date of October 27, 2000 based on U.S. Provisional Application No. 60/244,012. Therefore, the subject application qualifies under § 103(c). Giebeler has a publication date of November 28, 2002. Since Giebeler published after the earliest priority date of the instant application, Giebeler does not qualify as a prior art reference under 35 U.S.C. § 102(a) or (b) but can only be considered prior art under 35 U.S.C. § 102(e). Thus if the rejection is proper, it must be one under §§102(e)/103.

Giebeler and the instant application were, at the time the subject matter of the claimed invention was made, subject to an obligation of assignment to the same person. The instant application is assigned to Molecular Devices Corporation (see assignment recorded at reel/frame numbers 012833/0029). Giebeler is similarly assigned to Molecular Devices Corporation (see assignment recorded at reel/frame numbers 012897/0110). Because the instant application and Giebeler are subject to an obligation of assignment to the same person, Giebeler is

disqualified as prior art under § 103(c) and the rejection should be withdrawn.

For at least the reasons discussed above, Applicants submit that the claims are not obvious in view of the cited references. Accordingly, withdrawal of the § 103 rejections is respectfully requested.

Applicants submit that all of the pending claims are in condition for allowance and solicit action to that end. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact Applicant's undersigned representative.

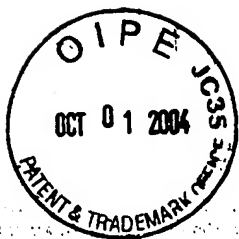
Respectfully submitted,

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Hon. Commissioner of Patents & Trademarks
Re: Applicant – Jackson III, et al.

Atty: RS
U.S.S.N. 10/003,030
Case No. 02-1057-A

"Light Detection Device"

Sir:

Please place the Patent Office receipt stamp hereon and mail to acknowledge receipt of the following:

- ☒ Transmittal Letter;
- ☒ Response to Office Action Mailed April 26, 2004; and
- ☒ Petition for Two Month Extension of Time.

Fee Enclosed
\$210.00

Respectfully,
McDonnell Boehnen Hulbert & Berghoff
Attorney for Applicant

Date Mailed: September 27, 2004